REMARKS

The Final Office Action mailed September 21, 2006, has been received and reviewed. Claims 1-4 and 8 are currently pending in the application. Claims 1-4 and 8 stand rejected. Applicant proposes to amend no claims herein, and respectfully request reconsideration of the application as presented herein.

Supplemental Information Disclosure Statement

Applicant notes the filing of Supplemental Information Disclosure Statement herein on November 21, 2005, and note that no copies of the PTO/SB/08A were returned with the outstanding Office Action. Applicant respectfully requests that the information cited on the PTO/SB/08A be made of record herein and that initialed copies of the PTO/SB/08A be returned to Applicant's undersigned attorney.

35 U.S.C. § 102(b) Anticipation Rejections

Anticipation Rejection Based on U.S. Patent No. 6,319,317 to Takamori

Claims 1-3 and 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Takamori (U.S. Patent No. 6,319,317). Applicant respectfully traverses this rejection, as hereinafter set forth.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131 (Aug. 2001) (*quoting Verdegaal Bros. v. Union Oil Co. of California,* 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Id.* (*quoting Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 1236, 9 USPQ2d 1051, 1053 (Fed. Cir. 1987)). In addition, "the reference must be enabling and describe the applicant's invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." *In re Paulsen,* 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Applicants submit that the Takamori reference does not and cannot anticipate under 35 U.S.C. § 102 the presently claimed invention of independent claim 1, and claims 2-3 and 8

depending therefrom, because the Takamori reference does not describe, either expressly or inherently, the identical inventions in as complete detail as are contained in the claims.

The Office Action alleges:

> Ushijima [sic] discloses system for selectively depositing a material on a previously formed workpiece, comprising a platform (Figure 4, item 52) for supporting the workpiece during a deposition process, a **sensing system (Figure 4, item 105) for measuring an upper surface of the workpiece and a surface level of a material deposited on the upper surface of the workpiece until the surface level of the material corresponds to a specific thickness of the material** (see, for example, column 12, lines 50-63); and a deposition system (item 86) for depositing the material on the workpiece to the specific thickness as monitored by the sensing system (see column 11, lines 53-58, and column 13, lines 42-53). The sensor measures the "spreading state" and therefore is a continuous measurement system. The apparatus can operate on the claimed die and claimed surfaces.
>
> **This sensing system** for measuring an upper surface **is considered capable of** measuring an[] upper surface over a semiconductor die including the upper surfaces and including a previous material previously deposited thereon. **This apparatus in Takamori is considered capable of** coating any type of substrate, including the claimed semiconductor die including a previous material previously deposited thereon. (Office Action pp. 2-3; emphasis added).

Applicants respectfully disagree that the Takamori reference anticipates Applicants' invention as claimed in independent claim 1 which reads:

> 1. A system for selectively depositing a material on a previously formed workpiece, comprising:
>
> a platform for supporting the workpiece including a semiconductor die during a deposition process;
>
> **a sensing system configured *to measure*** over the semiconductor die ***both*** **an upper surface including a previous material previously deposited thereon and to continuously measure a surface level of a material being deposited on the upper surface** until the surface level of the material corresponds to a specific thickness of the material; and
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> a deposition system for depositing the material on the workpiece to the specific thickness as monitored by the sensing system. (Emphasis added.)

Applicants respectfully assert that the Takamori reference cannot anticipate under 35 U.S.C. § 102 Applicants' invention as presently claimed on at least two separate grounds, namely:

(1) The "sensing system" of the Takamori reference does not disclose a "system configured to measure … both an upper surface … and to continuously measure a surface level of a material being deposited", as claimed by Applicants; and

(2) The legal standard for a proper anticipation rejection under 35 U.S.C. § 102 is not a mere assertion that an examiner considers a reference capable of performing an element of Applicants' invention as claimed.

Applicants' invention as claimed recites, among other things, "a sensing system ***configured to measure*** over the semiconductor die ***both an upper surface*** including a previous material previously deposited thereon ***and to continuously measure a surface level of a material being deposited on the upper surface*** until the surface level of the material corresponds to a specific thickness of the material". In distinct contrast, the Takamori reference's alleged "sensing system (Figure 4, item 105) discloses a camera that detects the outline of the periphery of the resist solution spreading across a wafer to determine if the spreading state is acceptable (i.e., generally circular) or if the resist has an improper consistency resulting in undesirable spreading (i.e., varying radius or wave-like periphery) known as a "scratchpad." At most, the Takamori "sensing system" discloses pattern recognition (i.e., distinguishing between a circular periphery of the resist and an undesirable waveform periphery of the resist) and not a system "configured to measure … both an upper surface … and … a surface level of a material being deposited on the upper surface" as claimed by Applicants.

Specifically, the Takamori reference discloses:

> … detecting sensor 105 for detecting a spreading state of an outline of the outer periphery of the resist solution when the resist solution is discharged onto almost the center of the rotated wafer W and the resist solution spreads out from almost the center of the wafer W toward the outer edge. As this detecting sensor 105, for example, a CCD camera can be used. (Takamori, col. 8, lines 30-36).
>
> … the spreading state of the outline of the outer periphery of the resist solution R is detected by the detecting sensor 105 such as a CCD camera or the like …. (Takamori, col. 9, lines 44-46).

The "sensing system" of the Takamori reference clearly is **not** "***configured to measure*** ... ***both an upper surface*** including a previous material previously deposited thereon ***and to continuously measure a surface level of a material being deposited on the upper surface*** until the surface level of the material corresponds to a specific thickness of the material" as claimed by Applicants. Therefore, the Takamori reference **cannot** anticipate under 35 U.S.C. § 102 Applicants' invention as presently claimed in independent claim 1 from which claims 2-3 and 8 depend. Accordingly, Applicants respectfully request the rejections be withdrawn.

Furthermore, the legal standard for a proper anticipation rejection under 35 U.S.C. § 102 is not a mere assertion that an examiner considers a reference capable of performing an element of Applicants' invention as claimed. The legal standard for a proper anticipation rejection under 35 U.S.C. § 102 requires "each and every element as set forth in the claim [be] found, either expressly or inherently described, in a single prior art reference" and "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." M.P.E.P. § 2131 (Aug. 2001) (*quoting Verdegaal Bros. v. Union Oil Co. of California,* 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). *Id.* (*quoting Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 1236, 9 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

The fact that an examiner alleges that a reference "is considered capable of" performing claim elements is inadequate if the cited reference would not inherently need such a capability. Therefore, the Takamori reference **cannot** anticipate under 35 U.S.C. § 102 Applicants' invention as presently claimed in independent claim 1 from which claims 2-3 and 8 depend. Accordingly, Applicants respectfully request the rejections be withdrawn.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness rejection of claim 4 based on U.S. Patent No. 6,319,317 to Takamori as applied to claims 1 through 3 and 8 above, and further in view of U.S. Patent No. 6,642,155 to Whitman

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Takamori (U.S. Patent No. 6,319,317) as applied to claims 1 through 3 and 8 above, and further in view of Whitman (U.S. Patent No. 6,642,155). Applicant respectfully traverses this rejection, as hereinafter set forth.

The nonobviousness of independent claim 1 precludes a rejection of claim 4 which depends therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. *See* In re Fine, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), *see also* MPEP § 2143.03. Therefore, the Applicant requests that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to dependent claim 4 as independent claim 1 is allowable.

ENTRY OF RESPONSE

The proposed response above should be entered by the Examiner because the remarks are supported by the as-filed specification and drawings and do not add any new matter to the application. Further, the remarks do not raise new issues or require a further search. Finally, if the Examiner determines that this response does not place the application in condition for allowance, entry is respectfully requested upon filing of a Notice of Appeal herein.

CONCLUSION

Claims 1-4 and 8 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicant's undersigned attorney.

Respectfully submitted,

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